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EXAMINER

BLAKE, CAROLYN T

ART UNIT PAPER NUMBER

3724

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/701,873

Applicant(s)

NORMINGTON, DIANA AMELIA

Examiner

Carolyn T Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 4,6-8,10,14,15,19,21,22,24,28,29,32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 9, 11-13, 16-18, 20, 23, 25-27, 30, and 31 is/are rejected.
- 7) ☒ Claim(s) 1,9 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species II in the reply filed on December 16, 2004 is acknowledged. The traversal is on the ground(s) that all the species are the same in function, although different in appearance, and therefore should not be restriction. This is not found persuasive. For a proper traversal, Applicant is required to submit evidence or admit on the record that the species are obvious variants of each other. Applicant has not done this.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 4, 6-8, 10, 14, 15, 19, 21, 22, 24, 28, 29, 32, and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

### ***Specification***

3. The disclosure is objected to because of the following:

- Page 5, line 3: "th" should be changed to - -the- -.
- Page 12, line 3: "angl" should be changed to - -angle- -.
- Page 13, line 1: "rel ase" should be changed to - -release- -.

Appropriate corrections are required.

### ***Claim Objections***

4. Claim 1, line 4, recites the limitation "the amount" without proper antecedent. Change to - -an amount- -.

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5. Claim 1, line 14, recites the limitation "the base (1)" without proper antecedent. Change to - -a base (1)- -.
6. Claim 9 is objected to because line 3 reads "wh n, " while it should likely read - -when- -. Appropriate correction is required.
7. Claim 16, line 4, recites the limitation "the amount" without proper antecedent. Change to - -an amount- -.
8. Claim 16, line 14, recites the limitation "the base (1)" without proper antecedent. Change to - -a base (1)- -.
9. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).
10. Misnumbered claim 32 has been renumbered 33.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1, 16, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. Claim 1 recites the limitation "the moveable cutting die" in line 3. There is insufficient antecedent basis for this limitation in the claim.

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14. Claim 1 recites the limitation "the punch pattern" in line 4. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 1 recites the limitation "the punch " in line 10. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 16 recites the limitation "the moveable cutting die" in line 3. There is insufficient antecedent basis for this limitation in the claim.

17. Claim 16 recites the limitation "the punch pattern" in line 4. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 16 recites the limitation "the punch " in line 10. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 30 recites the limitation "the moveable cutting die" in line 4. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 30 recites the limitation "the punch pattern" in line 5. There is insufficient antecedent basis for this limitation in the claim.

21. Claim 30 recites the limitation "the sheet of material" in line 6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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23. Claims 1-3, 5, 11, 12, 16-18, 20, 25, 26, 30, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Farmwald et al (2,816,608).

Regarding claims 1 and 16, Farmwald et al disclose a machine for piercing sheets of material comprising: an adjustable apparatus (45) that can be moved by hand; the adjustable apparatus (45) acts as a stop to the moveable cutting die (30) containing the punch pattern thereby varying the amount of the punch pattern cut into a sheet of material being punched; the moveable cutting die (30) is designed with a cutting surface so that said adjustable apparatus (45) can limit the amount of said sheet of said material cut by said cutting surface; the adjustable apparatus (45) can be moved to a position so that said designed pattern of said punch is cut fully out of said sheet of said material by the movement of said moveable cutting die (30); a frame which holds said adjustable apparatus (45) and said moveable punch cutting die (30) with said moveable cutting die (30) held in the top of said frame and a hole (37) corresponding to said moveable cutting die (30) in the base (31) of said frame wherein said frame aligns said moveable cutting die (30) to said hole (37) allowing for said moveable cutting die (30) to be moved through said hole (37); a slot (area between 30 and 31) in said frame with said slot extending partially through said frame to accept and restrain said sheet of said material prior to said sheet of said material being punched; a means to activate (18, 19, 27, 28, etc.) said moveable cutting die (30) moving said cutting die (30) to where it contacts said sheet of said material in said slot cutting said sheet of said material, and a spring (9) installed within said

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frame to return said moveable cutting die (30) to a starting position allowing easy removal of said sheet of said material.

Regarding claims 2 and 17, Farmwald et al disclose the cutting surface is formed in a curved shape. Note the movable cutting die (30) is a cylinder, so thus the cutting surface is curved.

Regarding claims 3 and 18, Farmwald et al disclose the cutting surface is formed in a line at an angle to the top surface of said sheet of said paper.

Regarding claims 5 and 20, Farmwald et al disclose the adjustable apparatus (45) is a threaded piece of hardware (48) that is located in a matching threaded insert attached to said frame such that said threaded piece of hardware (48) can be rotated within said threaded insert (46) moving said threaded piece of hardware (48) up and down thereby adjusting and controlling the amount of travel of said moveable cutting die (30) and acting as said stop.

Regarding claims 11 and 25, Farmwald et al disclose a housing (1, 5, 6, 10) to enclose said frame and a portion of said means of activating said moveable cutting die (30).

Regarding claims 12 and 26, Farmwald et al disclose a portion of said adjustable apparatus (45) is fabricated as part of said housing.

Regarding claim 30, Farmwald et al disclose an adjustable apparatus (28) that can be added to existing decorative punches comprising: said adjustable apparatus (45) acts as a stop to the moveable cutting die (30) containing the punch pattern thereby limiting the amount of said punch pattern cut into the sheet of material being punched; said moveable cutting die (30) is designed with a

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curved cutting surface so that said adjustable apparatus (45) can limit the amount of paper cut by that cutting surface, said adjustable apparatus (45) can be moved to a position so that said designed pattern of said punch is cut fully out of said sheet of material, and said adjustable apparatus (45) can be permanently installed on existing decorative punches.

Regarding claim 31, Farmwald et al disclose an adapter (45) designed to fit on a machine for piercing paper comprising: an adjustable apparatus (45) that can be moved by hand; said adjustable apparatus (45) acts as a stop to the downward motion of said machine thereby controlling the amount of the pattern of said machine that is cut into a sheet of material being pierced; and said adapter (45) can be attached to said machine.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 1- are rejected under 35 U.S.C. 103(a) as being unpatentable over Gouldsmith, Jr. (2, 730,811) in view of Farmwald et al.

Regarding claims 1 and 16, Gouldsmith, Jr. discloses a machine for piercing sheets of material comprising: a the moveable cutting die (66) containing the punch pattern thereby varying the amount of the punch pattern cut into a sheet of material being punched; the moveable cutting die (30) is designed with a



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cutting surface (68); a frame which holds said moveable punch cutting die (66) with said moveable cutting die (66) held in the top of said frame and a hole (20) corresponding to said moveable cutting die (66) in the base (10) of said frame wherein said frame aligns said moveable cutting die (66) to said hole (20) allowing for said moveable cutting die (66) to be moved through said hole (20); a slot (area between 68 and 10) in said frame with said slot extending partially through said frame to accept and restrain said sheet of said material prior to said sheet of said material being punched; a means to activate (84.) said moveable cutting die (66) moving said cutting die (66) to where it contacts said sheet of said material in said slot cutting said sheet of said material, and a spring (80) installed within said frame to return said moveable cutting die (66) to a starting position allowing easy removal of said sheet of said material. Gouldsmith, Jr. fails to disclose an adjustable apparatus. However, Farmwald et al disclose an adjustable apparatus (45) for use in a piercing machine that is capable of adjustment to vary the distance between the punch and the die in order to compensate for wear of the die (col. 3, lines 1-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an adjustable apparatus, as disclosed by Farmwald et al, on the Gouldsmith, Jr. device for the purpose of varying the distance between the punch and die in order to compensate for wear.

Regarding claims 2 and 17, Gouldsmith, Jr. discloses the cutting surface (68) is formed in a curved shape.

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Regarding claims 3 and 18, Gouldsmith, Jr. discloses the cutting surface (68) is formed in a line at an angle to the top surface of said sheet of said paper.

Regarding claims 5 and 20, Farmwald et al disclose the adjustable apparatus (45) is a threaded piece of hardware (48) that is located in a matching threaded insert attached to said frame such that said threaded piece of hardware (48) can be rotated within said threaded insert (46) moving said threaded piece of hardware (48) up and down thereby adjusting and controlling the amount of travel of said moveable cutting die (30) and acting as said stop.

Regarding claims 11 and 25, Gouldsmith, Jr. discloses a housing (38) to enclose said frame and a portion of said means of activating said moveable cutting die (66).

Regarding claims 12 and 26, Farmwald et al disclose a portion of said adjustable apparatus (45) is fabricated as part of said housing.

Regarding claims 13 and 27, Gouldsmith, Jr. discloses a locking hinge mechanism (34) located at said base (10) of said machine where said locking hinge mechanism (34) allows said base (10) to be moved away from the rest of said machine following said material piercing thereby allowing for easy release of said material and said locking hinge mechanism (34) then allows base (10) to be returned to the original storing position.

26. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmwald et al as applied to claims 1 and 16 above, and further in view of Tanaka (3,472,101). Farmwald et al fail to disclose the means to activate is a lever. However, Tanaka disclose a machine for piercing sheets

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wherein the means to activate a moveable cutting die (6) is a lever (3) in contact with said moveable cutting die (6), thereby creating the necessary motion when said lever (6) is pushed and wherein said lever (6) is held against the force created by a spring (14) by portions of the frame. Making the device manually operated would make the device less expensive to operate. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the Farmwald et al device manually operated, as taught by Tanaka, by replacing the structure associated the pressure fluid operation, including the cylinder (6), with the lever of the Tanaka device for the purpose of decreasing operating expenses.

### ***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Capewell (749,257) discloses an adjustment mechanism.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CB

February 4, 2005



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